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EWH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Howard Publishing Company

Serial No. 76/202,319

Edward D. Lanquist, Jr. for Howard Publishing Company.

Angela R. Holmes, Trademark Examining Attorney, Law Office
106 (Mary I. Sparrow, Managing Attorney).

Before Hanak, Bucher and Rogers, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge.

Howard Publishing Company (applicant) seeks to
register in typed drawing form HUGS for "religious and
inspirational books." The application was filed on January
30, 2001, with a claimed first use date of August 26, 1997.

Citing Section 2(d) of the Trademark Act, the
Examining Attorney has refused registration on the basis
that applicant's mark, as applied to applicant's goods, is
likely to cause confusion with the identical mark HUGS
previously registered in typed drawing form for

"educational books and educational newsletters, all relating to personal guidance of the user to better individual mental and physical health through mental discipline, physical exercise, and choice of food; and educational prerecorded video tapes sold as a unit with books and newsletters relating to personal guidance of the user to better individual mental and physical health through mental discipline and physical exercise."

Registration No. 1,977,637.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request an oral hearing.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarity of the marks and the similarity of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

Considering first the marks, they are identical. Thus, the first Dupont "factor weighs heavily against applicant" because applicant's mark is identical to the

registered mark. In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Turning to a consideration of applicant's goods and registrant's goods, we note that because the marks are identical, their contemporaneous use can lead to the assumption that there is a common source "even when [the] goods or services are not competitive or intrinsically related." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993). However, in this case we find that the Examining Attorney has established that applicant's types of books and registrant's types of books are clearly related.

To elaborate, the Examining Attorney has made of record numerous stories from the Nexis database and the Internet which demonstrate that there are a significant number of books which cover both religious and inspirational topics as well as physical and mental health, including diet. For example, a story appearing in the April 3, 1994 edition of the Denver Rocky Mountain News contains the following sentence: "The hottest-selling religious books offer advice on how to ... lose weight." The May 25, 1998 edition of The Baltimore Sun contains the following sentence: "The all-American craze to lose weight is coming to the sanctuary. Christian diet workshops - a

combination of inspirational audio and videotapes, books, prayer meetings and Bible studies - are multiplying like Jesus-blessed loaves and fishes. Two highly publicized programs, and a plethora of smaller ones, are spreading by word of mouth through church members." The March 18, 1993 edition of USA Today contains the following sentence: "Some of the new diet books were written specifically to motivate and include inspirational stories." Finally, there are a number of Internet stories about a book entitled The Joy of Weight Loss whose theme is that one can lose unwanted pounds by strengthening his or her relationship with God.

In short, the numerous Nexis and Internet stories made of record by the Examining Attorney demonstrate that the purchasing public has been exposed to numerous books, newsletters and video tapes which deal with both religious and inspirational topics (the subject of applicant's books) as well as physical health, mental health and diet topics (the subject of registrant's books, newsletters and video tapes). Accordingly, we find that applicant's particular type of books is clearly related to registrant's types of books, not to mention newsletters and videotapes.

One final comment is in order. During the application process applicant properly made of record the declaration of John Howard, applicant's president. Mr. Howard stated

that he visited registrant's web site and determined that registrant's books "appear to be sold only through the weight loss programs," whereas applicant's books "are sold in bookstores." (Howard declaration paragraph 2). At page 2 of its reply brief, applicant then makes the following argument: "The examining attorney is correct that she must presume that registrant's goods are as listed in the registration. However, the presumption is rebuttable if registrant's goods are actually better defined by what is in the marketplace." Applicant's latter comment is simply not a correct statement of the law. It is well settled that in Board proceedings, "the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in [the cited] registration, rather than what the evidence shows the goods and/or services to be." Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). There is simply nothing in registrant's identification of goods that precludes the sale of its books, newsletters, and videotapes through bookstores. Thus, both applicant's and registrant's goods are presumed to travel in the identical channels of trade, namely, bookstores.

As for applicant's argument that its type of books and registrant's books would be sold in different sections of bookstores, we have two comments. First, given the Examining Attorney's evidence showing that the line between, on the one hand, religious and inspirational books and, on the other hand, physical fitness, mental fitness and diet books has become blurred, we are by no means certain that in all cases applicant's books and registrant's books would be sold in different sections of bookstores. Second, and more importantly, even if applicant's books and registrant's books would be sold in different sections of bookstores, we are of the firm belief that given the fact that registrant has adopted the identical, arbitrary mark (HUGS) previously used by registrant, that there would still be confusion.

Decision: The refusal to register is affirmed.